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10/595,488	05/08/2006	Yasuhiro Hidaka	3712174-548	1355
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EXAMINER				
RUST, ERIC A				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary

Application No.

10/595,488

Applicant(s)

HIDAKA, YASUHIRO

Examiner

ERIC A. RUST

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 03/22/2010

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 22, 2010 has been entered.

In the Amendment filed on March 22, 2010, Applicants canceled claims 19-36 and added claims 37-48. Accordingly, claims 37-48 are pending.

Information Disclosure Statement

2. The information disclosure statement filed March 22, 2010 fails to comply with 37 CFR 1.98(a)(3), which requires a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language, and a copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). The IDS has been placed in the application file, but the information referred to therein, specifically Japanese Office Action issued on December 8, 2009, for

corresponding Japanese Patent Application No. 2003-365047, has not been considered.

Miscellaneous

Applicant requests that the Examiner consider (a) Photoshop 6.0 Technical bible, Softbank Publishing Inc., 1st edition, 25 January, 2001, pp. 67- 68; (b) Totte Karaga Shobul" no Digital Camera Katsuyo technique," Nikkei Zero-One, N1KKEI HOME PUBLISHING, INC., No. 52, 01 September, 2000, pp. 44-57; and (c) "Digital Camera Gazo o Online Print," Nikkei Personal Computing, Nikkei Business Publications, Inc., No. 409, 13 May, 2002, pp. 98-105. *See* Amendment, pg. 8.

Specifically, Applicant states that the references, cited in an Information Disclosure Statement submitted on April 21, 2006, were cited in the PCT search report dated December 28, 2004 which was submitted on April 21, 2006 in the present application, and that this would seem to meet the minimum requirements of 37 CFR 1.98(a)(3) based on the relevant portions cited by the PCT search report. *See Id.*

The Examiner has considered this argument, but believes that the any information cited in an IDS and not considered by the Examiner failed to comply with 37 CFR 1.98(a)(3). First, the Examiner does not believe that the PCT search report, mentioned by the Applicant, is prepared by an individual designated in 37 CFR 1.56(c).

Second, it is the Examiners opinion that PCT search report cited by the Applicant does not meet the requirements of a concise explanation of the relevance of the documents, as required by 37 CFR 1.98(a)(3).

Applicants further requested that the Examiner consider the Japanese Office Actions cited in the IDS filed on September 21, 2009. *See Id.*

However, as noted above with respect to the Japanese Office Action cited in the IDS filed on March 22, 2010, the Japanese Office Actions cited in the IDS filed on September 21, 2009 does not comply with 37 CFR 1.98(a)(3).

Accordingly, Applicant's request is denied. If the Applicant feels that the Examiner is in error, the Applicant is encouraged to contact the Examiner to specifically point out the supposed error.

Claim Objections

3. Claims 38, 40, and 44 are objected to because of the following informalities:

In regard to claim 38, "execute," recited in line 1 appears to be a typographical error. The Examiner recommends amending the claim to recite "executed."

In regard to claims 40 and 44, both claims require a period at the end.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2001/0053247 A1 to Sowinski et al. (hereinafter, Sowinski) in view of U.S. Patent No. 7,236,960 B2 to Manico et al. (hereinafter, Manico).

In regard to claims 37, 41, and 45, Sowinski discloses a print-ordering system comprising: a user terminal having a display device (Sowinski, Fig. 5 for user terminal, Fig. 5, item 509 for display device); a server having an image database (Sowinski, Fig. 6, and [0127], image database is inherent since sample images are being used); a print system; at least one processor (Sowinski, Fig. 5, item 505 and/or 510); at least one memory device (Sowinski, Fig. 5, item 511) storing a plurality of instructions which when executed by the at least one processor, cause the at least one processor to operate with the user terminal (Sowinski, [0152]), the server and the print system to:

(a) enable a user to select:

(i) a predetermined sample image stored in the image database
(Sowinski, [0127]);

(b) in response to the predetermined sample image being selected:

(i) cause the server to generate a plurality of first image-processing-mode-selection images based on said predetermined sample image, each of said first image-

processing-mode-selection images being subjected to different image processes

(Sowinski, Fig. 10, item 104, and [0127]);

(ii) cause the display device to display each of said generated first image processing-mode-selection images **(Sowinski, Fig. 10, item 104, and [0127]);**

(iii) enable the user to select one of the displayed first image-processing-mode-selection images **(Sowinski, Fig. 10, item 104, and [0127]);**

(iv) in response to one of the displayed image-processing-mode-selection images being selected, cause the server to store a first image processing mode based on said selected first image-processing-mode-selection image **(Sowinski, Fig. 10, item 104, and [0127]); and**

(v) cause the printer system to execute print processing based on the first image processing mode stored by said server **(Sowinski, Fig. 10, item 104, and [0127], and [0140], based on first, second, and third image processing mode, this, of course, includes first image processing mode).**

It does not appear that Sowinski discloses enabling a user to select an image stored in the user terminal; and in response to the image stored in the user terminal being selected:

(i) transmitting the image stored in the user terminal to the server;

(ii) causing the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes;

(iii) causing the display device to display each of said generated second image-processing-mode-selection images;

(iv) enabling the user to select one of the displayed second image-processing-mode-selection images;

(v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing mode based on said selection of the displayed second image- processing-mode-selection image; and

(vi) causing the printer system to execute print processing based on the second image processing mode stored by said server.

The Examiner notes, however, that the only difference between claim 37 and Sowinski is that claim 37 allows a user to select his own image on the client device and then use that image for the processing that would be done on the sample image as disclosed in Sowinski.

Taking this into consideration, Manico discloses using an image provided by a user for presentation processing (**Manico, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention use the teachings of Manico for using a users own image for processing presentation with the teachings of Sowinski in order to increase the amount of images available to a user. This would increase user satisfaction.

The combination of Manico and Sowinski would result in the limitations of claim 37.

In regard to claims 38, 42, and 46, which depend from claims 37, 41, and 45, respectively, the combination of Sowinski and Manico disclose wherein when execute by the at least one processor, the instructions cause the processor to operate with the user terminal and the server to, for at least one of the first image processing mode and the second image processing mode, transmit, to the User terminal, at least two image-processing-mode-selection images obtained by performing a multilevel-image processing (**Sowinski, Fig. 10, item 104, and [0127], and Manico, Abstract**).

In regard to claims 39, 43, and 47, which depend from claims 37, 41, and 45, respectively, the combination of Sowinski and Manico disclose wherein when execute by the at least one processor, the instructions cause the processor to operate with the user to terminal to:

(a) enable the user to select a type of image processing mode (**Sowinski, Fig. 10, item 104, and [0127]**); and

(b) determine the first or the second image processing mode based on said selected type (**Sowinski, Fig. 10, item 104, and [0127], and Manico, Abstract**).

In regard to claims 40, 44, and 48, which depend from claims 37, 41, and 45, respectively, Sowinski discloses the first image processing mode and the second image processing mode include outline emphasis, hue, color density, gradation or contrast (**Sowinski, [0126], lines 3-12, hue**).

Response to Arguments

6. Applicants' arguments with respect to claims 37-48 have been carefully considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-270-4380.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/ERIC A. RUST/

Examiner, Art Unit 2625

04/22/2010

/Benny Q Tieu/

Supervisory Patent Examiner, Art Unit 2625